

## REMARKS

### Claim rejections under 35 USC 103

Claims 1-35 have been rejected under 35 USC 103(a) as being unpatentable over Grasso (2002/0116291) in view of Hamzy (6,623,527). Claims 1, 8, 19, and 26 are independent claims, from which the remaining claims rejected on this basis ultimately depend. Applicant submits that claims 1, 8, 19, and 26 are patentable over Grasso in view of Hamzy, such that all the pending claims are patentable over Grasso in view of Hamzy.

Claim 1 is discussed as representative of all the independent claims 1, 8, 19, and 26, insofar as patentability over Grasso in view of Hamzy. In the previous office action response, Applicant had argued that the claimed invention was directed to first configuring and storing data, then (next) sending instructions that identify this data, and finally printing the data. The Examiner appears to have provided two countering arguments to Applicant's suppositions. First, the Examiner seems to have indicated that the broadest reasonable interpretation of the claim language does not necessarily support Applicant's interpretation of the claim language. Second, the Examiner seems to have argued that Grasso in view of Hamzy nevertheless teaches Applicant's interpretation of the claim language. Applicant therefore limits the discussion herein to countering these two arguments of the Examiner.

Prior to providing this discussion, an "executive summary" of this discussion is presented; these are the "take home" points that are described in considerable detail below.

- The claimed invention has been amended to explicitly clarify the order in which the steps/acts are performed in the claimed invention.
- As to the claim limitation that the data in question is configured and stored prior to providing generic access instructions, the Examiner needs to indicate what these "generic access instructions" are in Grasso in view of Hamzy in order to maintain

*prima facie* obviousness of the claimed invention. Thus, as to this limitation, Grasso in view of Hamzy cannot currently be considered as teaching the order of steps/acts as in the claimed invention, insofar as it is unclear what the “generic access instructions” of the claimed invention are in Grasso in view of Hamzy.

- As to the claim limitation that the data in question is configured and stored prior to providing a print dialog box for printing the data, Grasso in view of Hamzy teaches the opposite process, that the printing process is first initiated (corresponding to providing a print dialog box) and then the data is stored. Thus, as to this limitation, Grasso in view of Hamzy does not teach the order of steps/acts as in the claimed invention.

These bullet point items are now discussed in detail; the first bullet point item is discussed initially, and then the second and third bullet points items are discussed together.

#### *Clarification of claim language*

First, to clarify the claim language so that the only interpretation that can be afforded thereto is that which was presented by Applicant in the previous office action response, the claimed invention has been amended so that: (1) it is clear that “said data is configured and stored *prior to* sending the generic access instructions”; and, (2) it is clear that “said data is configured and stored prior to providing the print dialog box for printing of said data by the printing apparatus.” The effect of this amendment is to temporally limit the order in which the various steps or acts of the claimed invention are performed. Thus, the data *has to be* configured and stored first, before the generic access instructions are sent, insofar as “said data is configured and stored *prior to* sending the generic access instructions.” Likewise, second, the data *has to be* configured and stored first, before providing the print dialog box for printing of the data, insofar as “said data is configured and stored *prior to* providing the print dialog box for printing of said data.” In this respect, then, Applicant submits that the interpretation afforded by the claims, by Applicant, in the previous office action response is the correct and indeed only interpretation that can be so proffered. It is the reasonable and broadest interpretation of the claims, in light of the explicit amendments made in the instant office action response.

*Grasso in view of Hamzy does not teach order of steps/acts as in the claimed invention*

Second, Applicant counters the Examiner's contention that Grasso in view of Hamzy can configure and store data *prior to* sending the generic access instructions and *prior to* display of a dialog box for printing the data. Because the "generic access instructions" of the claimed invention are central to this inquiry, Applicant in particular first looks at what the Examiner is identifying as these generic access instructions in Grasso in view of Hamzy. The Examiner has found this limitation in paragraphs [0059] and [0063] of Grasso in particular. These two paragraphs state the following:

[0059] The user 50 picks up the print job from his own printer 112. The user 50 can access browse, search and any other service via the web site 130 of the service provider 210. The customer can also access to services via a paper-based user interface 110 (such as FlowPort forms) by scanning the filled-in form 122 on a FlowPort enabled MFD 110. As described in copending application D99457, the printed document may be preceded by a special banner page which may be a FlowPort form allowing the user to conduct further interactions with the service provider on paper. Because the cover sheet 122 is uniquely identified, it constitutes a pointer to the stored document in the digital archive.

[0063] From a network perspective, it is assumed that the user has a local area network that is linked to the Internet by a router, in order to allow the service provider 210 to transmit a print job to the user's printer. This configuration implies also the usage of a firewall 140. While very frequent for offices, even small ones, this configuration is less common in home offices, but home office networks may be more popular in the future. To minimize the time delay caused by sending the print document to service provider 210 which processes the document before the document is released, an alternative approach is to send a copy of the print job to the service provider (a carbon copy to the service provider rather than a print through it). This can be accomplished by modifying the print spooler. In this embodiment, the service provider can extract the data needed from the document while the local printer is generating the print job. However, in this alternative embodiment, the service provider may not be able to provide information via the print cover sheet. This embodiment eliminates the need for granting printer access to the service provider, reduces by a factor of two the size of data transmitted over the Internet and does not slow down the print time.

As to paragraph [0059], it is unclear what the “generic access instructions” are in this paragraph, and therefore Applicant requests that the Examiner indicate what the “generic access instructions” are in paragraph [0059]. Likewise, as to paragraph [0063], it is unclear what the “generic access instructions” are in this paragraph, and therefore Applicant requests that the Examiner indicate what the “generic instructions” are in paragraph [0063]. Applicant can find no reference to “generic access instructions” in any form in either of these paragraphs of Grasso. Where the claimed invention is predicated on the data in question to be configured and stored prior to sending these generic access instructions, it is imperative that the Examiner identify what these instructions are in Grasso in view of Hamzy for proper *prima facie* obviousness.

Furthermore, however, Applicant strongly submits that Grasso in view of Hamzy does not teach, disclose, or suggest configuration and storage of data *prior to* sending the generic access instructions and *prior to* providing the print dialog box for printing of this data. Applicant explained this in detail in the previous office action response, and thus in this response quotes from the previous response as an initial matter, and then responds to the Examiner’s additional comments in the final office action. Therefore, first, as noted in the previous office action response:

Let us boil down what Grasso teaches in paragraphs [0057]-[0064] a bit. A user accesses services provided by a service provider. To start this process, the user prints a document – i.e., the user initiates printing of a document. In particular, the service provider either initially receives the document upon the user requesting this document to be printed (para. [0058]) or intercepts the document as it is being printed (para. [0063]), and stores the document. The user picks up the printed document (which may be printed by the service provider sending the document for printing, as in para. [0058], or printed directly from the user’s computer, as in para. [0063]). The user then can access services related to this document (as stored by the service provider), which are provided by the service provider, via web access.

Thus, the entire process in Grasso, and therefore in Grasso in view of Hamzy, is predicated upon a user printing a document. The user initiating the printing process causes a digital copy of the document to be stored at the service provider. Once the document has been printed, the user can then access services

provided by the service provider that are related to the document as to which the digital copy thereof has been previously stored.

On a most general level, then, it should be readily apparent why Grasso in view of Hamzy does not teach, disclose, or suggest the claimed invention. In the claimed invention, you first configure data, store the data, send instructions that identify the data that has been stored for printing the data, and then a printing apparatus sends other instructions so that the data that has been stored and identified can be accessed and printed at the printing apparatus. The process of Grasso in view of Hamzy, however, is nearly the complete opposite! In Grasso in view of Hamzy, the data is not stored until the printing process has already been initiated. No instructions are needed to identify the data that has been stored for access thereto for printing the document, as in the claimed invention, insofar as the data is not even stored until printing of the document has been initiated.

That is, at a most general level, you can look at the claimed invention as providing the following process: configuring data → storing data → sending instructions → identifying the stored data based on these instructions → sending instructions for printing the data as has been stored and identified. By comparison, at a most general level, Grasso in view of Hamzy at best teaches the following process: configuring data → printing data → storing the data. In the claimed invention, the data is first configured and stored, and then instructions have to be sent so that this data can be identified so that the data can be accessed for printing. In contradistinction, in Grasso in view of Hamzy, the data is stored *as part of the printing process* – specifically in response to the printing process being initiated. **In Grasso in view of Hamzy, in other words, there is no need to send access instructions to identify the data that has been stored so that the data can be printed, since the data is not even stored in the first place until printing of the data has been initiated.**

(Office action response of January 2, 2007, page 10.)

Now, the Examiner has stated in the final office action that “Grasso discloses that many different types of services now become available to the local user.” (P. 2) Examples include that recorded documents may be indexed for searching and fast retrieval in paragraph [0021] of Grasso. However, this example of Grasso does not belie Applicant’s presented interpretation of Grasso. Paragraph [0021] says that “[m]any different types of services *now* become available to the user.” In this respect, paragraph [0021] is a continuation of paragraph [0020] of Grasso, which states that “[w]hen printing, the user has the option of selecting a physical printer not on

the system or a ‘virtual printer’ on the system,” such that “[b]y printing on the system printer, the user enables the storage service, which keeps a print-ready version of the document.” As such, “[t]he availability of the printed documents . . . creates a workgroup memory of relevant (*because printed*) documents on top of which it is possible *to provide additional personal and collaborative services*.” These are the services that are “now” available in paragraph [0021] of Grasso.

What does all this mean? Well, as explained in detail in the previous office action response, a user can print a document, the printing of which results in a version of the document to be stored, so that additional services can be realized. However, note what this implies – *first* a user prints a document, *then* the document is stored for these additional services to be realized. This is opposite to the temporal order of things in the claimed invention, in which *first* the data is configured and stored, and *then* the data is printed. Paragraph [0021] of Grasso, in other words, supports Applicant’s contention that Grasso in view of Hamzy does not teach, disclose or suggest all the claim limitations of the claimed invention.

The Examiner in the final office action has also stated that “Grasso also discloses that the service provider 210 records the document 120 in the digital archive it hosts for the user 50, and upon request by the user 50, the service provider 210 then transmits the print job to the user’s printer 112 where the printed document is produced,” citing paragraphs [0058] and [0059] of Grasso. (Pp. 2-3.) These paragraphs actually recite, in relevant part:

To access the services, user 50 prints a document 120 through a local printer 112, which is connected to service provider 210. The service provider 210 records the document 120 in the digital archive it hosts for the user 50. It also processes the print job in order to provide the various document services. This processing may include storing a copy of the printed document 120, extracting text, content indexing and other services. Service provider 210 then transmits the print job to the user’s printer 112 where the printed document is produced . . . . The user 50 picks up the print job from his own printer 112. The user 50 can access browse, search and any other service via the web site 130 of the service provider 210.

So let us see what is going on here. The user prints a document through a local printer, which is connected to a service provider. The service provider records the document, and processes the print job to provide the services. The service provider also transmits the print job to the printer where the printed document is produced. Thus, in Grasso in view of Hamzy, a user initiates the printing process locally (i.e., “prints a document through a local printer”), which causes the document to be sent to a service provider, and the service provider then stores the document (i.e., “records the document in the digital archive). Thereafter, the service provider transmits the print job to the user’s printer for actual production of the document.

However, compare this temporal order of steps in Grasso in view of Hamzy with the temporal order of the claimed invention. In the claimed invention, the data in question is “stored prior to sending the generic access instructions.” Insofar as the Examiner has not pointed out what the “generic access instructions” are in Grasso in view of Hamzy, it is difficult to perform a proper analysis here. Again, Applicant requests that the Examiner identify what the “generic access instructions” particularly are in Grasso in view of Hamzy.

Furthermore, in the claimed invention, the data in question is “configured and stored prior to providing the print dialog box for printing of said data.” That is, in the claimed invention, the data is stored, and then a print dialog box is provided at some later point in time for printing of the data. By comparison, Grasso in view of Hamzy teaches the opposite process. In Grasso in view of Hamzy, a user *first* initiates the printing process locally – presumably through a print dialog box – and *after* this printing process has been initiated (i.e., after the print dialog box has been provided), the document is sent to the service provider for storage. In other words, in the claimed invention, you have data storage → print dialog box, whereas in Grasso in view of Hamzy, at best, you have print dialog box → data storage. Because Grasso in view of Hamzy indicates that it is initiation of the printing process that sends the data to the service provider for

storage of the data,<sup>1</sup> Grasso in view of Hamzy is contrary to the claimed invention, which initiates the printing process (e.g., via providing a print dialog box) after storage of the data. As such, Grasso in view of Hamzy does not render the claimed invention obvious.

Applicant finally reminds the Examiner of a point made in the previous office action response. In particular, Applicant is potentially amenable to any suggested additions to the claim language from the Examiner if such added claim language would satisfy the Examiner as to the patentable distinction between the claimed invention and that which is disclosed in Grasso in view of Hamzy. In this respect, the Examiner is very much encouraged to contact Applicant's representative, Mike Dryja, at the phone number listed below with such suggestions.

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<sup>1</sup> See, e.g., paragraph [0020] of Grasso ("By printing . . . the user enables the storage service"); see also, paragraph [0058] of Grasso ("To access the services, user 50 prints a document 120 through a local printer, which is connected to service provider 120 [that] records the document 120 in the digital archive.")



Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

Michael A. Dryja, Reg. No. 39,662  
Attorney/Agent for Applicant(s)

Law Offices of Michael Dryja  
704 228<sup>th</sup> Ave NE #694  
Sammamish, WA 98074  
tel: 425-427-5094  
fax: 206-374-2819